

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of	:	Customer Number: 46320
	:	
David KAMINSKY, et al.	:	Confirmation Number: 1386
	:	
Application No.: 10/635,598	:	Group Art Unit: 2451
	:	
Filed: August 6, 2003	:	Examiner: K. Tang
	:	
For: INTELLIGENT MAIL GATEWAY	:	

REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner For Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Reply Brief is submitted under 37 C.F.R. § 41.41 in response to the EXAMINER'S ANSWER dated October 28, 2008.

The Examiner's response to Appellants' arguments submitted in the Second Appeal Brief of August 8, 2008 (hereinafter the Second Appeal Brief), raises additional issues and underscores the factual and legal shortcomings in the Examiner's rejection. In response, Appellants rely upon the arguments presented in the Second Appeal Brief, and the arguments set forth below.

REMARKS

Appellants have compared the statement of the rejection found on pages 3-8 of the Examiner's Answer with the statement of the rejection found on pages 2-7 of the Third Office Action. Upon making this comparison, Appellants have been unable to discover any substantial differences between the respective statements of the rejection. As such, Appellants proceed on the basis that the Examiner's sole response to Appellants' Second Appeal Brief is found on pages 9-16 of the Examiner's Answer.

Non-Compliant Examiner's Answer

On page 8 of the Second Appeal Brief, Appellants pointed out where the Examiner's Answer is required to include particular content discussed in M.P.E.P. § 1207.02, yet the Examiner has completely ignored this requirement. As noted throughout the prosecution of this application and in the Second Appeal Brief, the Examiner has failed to properly establish the facts underlying the Examiner's analysis. Appellants' position is that these omissions in the Examiner's prima facie analysis are correctable by the Examiner, and the correction of these omissions would help both Appellants and the Honorable Board gain a better understanding of the alleged findings of facts and analysis employed by the Examiner in rejecting the claims. Thus, Appellants respectfully recommend that the Honorable Board remand the present application to the Examiner to address these omissions.¹

¹ The Board has persistently declined to uphold an Examiner because of omissions in the Examiner's half of the record. *E.g.*, Ex parte Daleiden, Appeal 2007-1003 (Mar. 14, 2007) (remanding because examiner failed to respond to arguments in the Appeal Brief); Ex parte Rozzi, 63 USPQ2d 1196, 1200-03 (BPAI 2002) (remanding without decision because of a host of examiner omissions and procedural errors); Ex parte Gambogi, 62 USPQ2d 1209, 1212 (BPAI 2001) ("We decline to tell an examiner precisely how to set out a rejection."); Ex parte Jones, 62 USPQ2d 1206, 1208 (BPAI 2001) (refusing to adjudicate an issue that the examiner has not developed); Ex parte Schricker,

Objection to the Specification

As noted in the Second Appeal Brief, Appellants recognize that this is not an appealable issue. However, since the Examiner chose to address Appellants' arguments on page 9 of the Examiner's Answer, Appellants will respond in kind.

There is no absolute requirement for "antecedent basis" for all of the claim terms. Instead, 37 C.F.R. § 1.75(d)(1) states that "the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." Thus, clear support, in the specification, for a claim term can satisfy the requirements of 37 C.F.R. § 1.75(d)(1).

In this regard, the Examiner is also referred to M.P.E.P. § 2173.05(c), which under the heading "A claim term which has no antecedent basis in the disclosure is not necessarily indefinite" states the following:

The mere fact that a term or phrase used in the claim has no antecedent basis in the specification disclosure does not mean, necessarily, that the term or phrase is indefinite. There is no requirement that the words in the claim must match those used in the specification disclosure. Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision. (emphasis added)

Also, original claims constitute their own description. In re Koller, 613 F.2d 819, 204 USPQ 702 (CCPA 1980). At the current time, over 1,500 patents have issued with at least one claim including the phrase "machine readable storage." Given the widespread use of these terms,

56 USPQ2d 1723, 1725 (BPAI 2000) ("The examiner has left applicant and the board to guess as to the basis of the rejection ... We are not good at guessing; hence, we decline to guess."); Ex parte Bracken, 54 USPQ2d 1110, 1112-13 (BPAI 1999) (noting that the appeal is "not ripe" because of omissions and defects in the examiner's analysis).

Appellants' position is that one having ordinary skill in the art would not require a definition and would have no trouble discerning a meaning for these terms simply based of the term itself. Therefore, Appellants respectfully submit that the Examiner's objection is not proper.

Rejection under 35 U.S.C. § 101

In response to the arguments presented on pages 5-7 of the Second Appeal Brief, the Examiner asserted the following in the paragraph spanning pages 10 and 11 of the Examiner's Answer:

Appellant allegedly stated that Claims 1-4 are statutory. However, as stated in the office action, appellant's specification (see page 11, par 0023) has evidently stating that the invention (e.g., an intelligent electronic mail (e-mail) gateway) can be realized in "software". Further, an intelligent e-mail gateway comprising: a message store configured to (a software module) and a notification manager (a software module), thus, a intelligent e-mail gateway comprising only software modules are considered to be a software per se, which does not fall in any statutory category.

At the outset, Appellants note that the Examiner has completely ignored Appellants' arguments presented in the Second Appeal Brief. For example, the Examiner has ignored Appellants' arguments that a "message store" is a device, and the Examiner's has ignored the Federal Circuit's analysis within In re Comiskey, which would have come out differently had the Examiner's analysis would have been employed.

Instead, the Examiner asserts that the claimed "message store" is a software module – without factual support and then asserts that the claimed "notification manager" is a software module – also without factual support. The Examiner's analysis is completely bereft of factual findings. Instead, the Examiner's analysis is solely based upon the naked assertion that all the limitations are software per se.

Based upon the Examiner's analysis, it is readily apparent that the Examiner misunderstands exactly what constitutes software *per se*. In particular, Appellants respectfully submit that the Examiner is confused as to exact meaning of the phrase "per se." The definition of legal term "per se" is the following:²

By itself; in itself; taken alone; by means of itself; through itself; inherently; in isolation; unconnected with other matters; simply as such; in its own nature without reference to its relation.

Thus, software *per se* is an abstract idea embodied by the software alone without anything else. For this reason, software *per se* is deemed to be non-statutory subject matter.

However, as evident from Figure 1 of Appellants' disclosure, the notification manager 200 and the message store 180 are not "in isolation; unconnected with other matters," as implied by the Examiner's assertion as to "software per se." Instead, Figure 1 clearly shows that both the notification manager 200 and the message store 180 are integrally tied into the mail gateway 140, which is clearly illustrated in Figure 1 as being a computer device. Thus, the claimed invention, as a whole, and given the broadest, reasonable meanings of the claim terms, is directed to statutory subject matter, and thus meets the requirements of 35 U.S.C. § 101.

Rejection of claim 1 under 35 U.S.C. § 102

On pages 10 and 11 of the Second Appeal Brief, Appellants raised several issues with regard to the Examiner's rejection of claim 1 based upon Tomkow. The Examiner's response to Appellants' arguments is found on pages 10-12 of the Examiner's Answer.

² Black's Law Dictionary 1142 (6th ed. 1990).

After Appellants argued that the Examiner's analysis was unclear as to the specific teachings with Tomkow being relied upon to teach the specific elements being claimed, the Examiner made the following assertions on pages 10 and 11 in which the Examiner alleged the following mappings between claimed elements and the teachings of Tomkow:

mail server (element 16, refer to Fig 3)
e-mail gateway (element 14, refer to Fig 3)
server RPost server 14 is capable to store messages forwarded by recipients.
notification manager is a functionality provided by Tomkow's RPost server 14

On page 10 of the Second Appeal Brief, Appellants argued that "the Examiner can only rely upon RPost server 16 to teach the claimed mail server since RPost server 14 is not associated with the corresponding intended recipients." The Examiner responded to this argument by citing paragraph [0150] of Tomkow and asserting the following "the message store is associated with the corresponding intended recipients" on page 11 of the Examiner's Answer. For ease of reference, paragraph [0150] of Tomkow is reproduced below:

3. the quoted body of the original message together with the e-mail addresses of its intended recipients.

Although this passage is not clear as to the context of what is being described, paragraph [0147] describes that a receipt 20 includes (1) an identifier (see paragraph [0148]); (2) a date and time (see paragraph [0149]); (3) the description reproduced above; (4) another date and time (see paragraph [0151]); and (5) a table (see paragraphs [0152]-[0157]). As described in paragraph [0147], receipts are "e-mails sent to the original sender of the made-of-record message."

Thus, to teach the claimed "message store ... associated with corresponding intended recipients," the Examiner relies upon a teaching describing the contents of a receipt (i.e., an e-mail from a recipient to a sender). Entirely absent from the Examiner's cited passage is any mention of (i) a message store; (ii) the message store being associated with intended recipients.

Not only has the Examiner failed to establish that the Examiner's cited passage teaches the limitations for which the Examiner is asserting that this passage teaches, the Examiner has failed to set forth any claim construction that explains why the Examiner believes that the limitations at issue are identically disclosed by paragraph [0150] of Tomkow.

A perfect analogy to the claimed "message store ... associated with corresponding intended recipients" would be a run-of-the-mill store that provides rental mail boxes (e.g., Mail Boxes Etc., UPS store, etc.) Once a user has rented a mail box, the specific store (at a specific location) acts as a message store associated with corresponding intended recipients. The analogy to the RPost server 16, however, is a post office or a communal outgoing mail box, from which mail to be sent is received. These entities, however, are not "associated with corresponding intended recipients." Thus, one having ordinary skill in the art would recognize that the RPost server 16 fails to identically disclose all of the limitations recited in claim 1.

In the second full paragraph on page 11 of the Second Appeal Brief, Appellants argued that paragraph [0097] of Tomkow does not teach the limitations associated with the claimed "notification manager." However, as noted earlier, Appellants proceeded under the assumption that the Examiner was relying upon RPost server 16 to teach the claimed mail server (and thus the notification manager) since RPost server 14 is not associated with the corresponding intended recipients. Referring to page 12 of the Examiner's Answer, the Examiner asserted the following:

The specific teaching could be found in Tomkow, par 0229, where "the notification information receipt that RPost will generate for the sender". Furthermore, Tomkow disclosing RPost 14 comprising functionality to notify senders the status when the message is unable to send to the recipient, see paragraph 0144, 0145, 0158, and specifically 0177.

Absent from the Examiner's cited passages, however, is a teaching that corresponds to the claimed "notifying selected ones of said senders when delivery to said intended recipients has become impaired" (emphasis added). Based upon the plain language of the claim, not all senders are necessarily notified when delivery has become impaired. Instead, selected ones of the senders are notified. None of the Examiner's cited passages teach these limitations. Thus, the Examiner has further failed to establish that Tomkow identically discloses all of the limitations recited in claim 1 within the meaning of 35 U.S.C. § 102.

Rejection of claim 2 under 35 U.S.C. § 103

In the first full paragraph on page 12 of the Second Appeal Brief, Appellants presented separate arguments as to dependent claim 2. The Examiner's response to these arguments is found on pages 12 and 13 of the Examiner's Answer and is reproduced below:

As already admitted in its argument by Appellant that the Horvitz teaches the concept of an alternate e-mail address, Horvitz further discloses that the its system is capable to present users an additional contact information such as an additional e-mail address when the user cannot be reached see par 0277.

The Examiner's appears to have miscomprehended Appellants' argument that "absent from the Examiner's cited passage is teachings as to the remainder of the limitations associated with the alternate e-mail address." Specifically, the "remainder of the limitations" are underlined – "associated with the alternate e-mail address with which said selected ones of said senders can retransmit said messages to corresponding intended recipients." Again, the concept of the "selected ones of said senders" is being claimed yet both the Examiner's analysis and the teachings of Horvitz are completely silent as to these limitation. Moreover, as claimed, the senders retransmit the messages. On the contrary, the router system 420 of Horvitz provides the routing. Referring to Fig. 24, Horvitz clearly indicates that the routing system 420 is separate

from the sender since the routing system sends a reply to the sender, which would not be required if the routing system and sender were one and the same.

Therefore, for the reasons submitted above, Appellants maintain that the Examiner has mischaracterized the scope and content of Horvitz.

Rejection of claim 12 under 35 U.S.C. § 103

In the second full paragraph on page 12 of the Second Appeal Brief, Appellants presented separate arguments as to dependent claim 12. The Examiner's response to these arguments is found on page 13 of the Examiner's Answer and is reproduced below:

According to the Appellant's claim limitation, the limitation does not further define what is "the nature of the impairment)." Tomkow teaches the alleged missing limitation. Tomkow discloses the notification send to sender disclosing the delivery has "failed" in par 0155. Tomkow further discloses the notification/delivery receipts of its system contains details information such as the delivery status, see par 0177. The mapping is comparable to the claimed "nature of said impairment" and is reasonably compared and reasonably interpreted.

Although the Examiner asserts that the claimed limitations have been reasonably interpreted, this is a self-serving conclusory statement. Based upon the plain language of "nature of said impairment," there are two characteristics being described: (i) the *impairment* and (ii) the *nature* of the impairment. As argued in the Second Appeal Brief, the teachings of Tomkow only describe a single characteristic (i.e., the delivery has failed). Thus, the Examiner has not properly interpreted the language of the claims and since the Examiner's analysis is based upon an improper claim construction, the Examiner has committed reversible error by not properly comparing the claimed limitations to the teachings of the applied prior art. Moreover, the applied prior art fails to teach the limitations for which the Examiner is relying upon the applied prior art to teach.

Rejection of claim 13 under 35 U.S.C. § 103

In the third full paragraph on page 12 of the Second Appeal Brief, Appellants presented separate arguments as to dependent claim 13. The Examiner's response to these arguments is found on pages 13 and 14 of the Examiner's Answer and is reproduced below:

Tomkow teaches the formatting a notification comprising a statement of said impairment and forwarding said detailed notification to said identified senders see par 0147-0162 and par 0177. Tomkow did not explicitly disclosing "an estimate of when normal mail delivery can resume." However, Horvitz discloses a similar teaching of formatting a notification comprising the alleged missing claim limitation: "an estimate of when normal mail delivery service can resume". Specifically, Horvitz discloses that "the expected time to return determination by the system may be automatically conveyed to senders of highly urgent messages, for example. In this manner, message sender receive feedback when the user is expected to return such that he or she can reply to the messages." see par 0268. Lines 7-12. This means that Horvitz teaches an estimated (i.e., feedback when the user is expected to return) of when normal mail delivery service can resume (i.e., the user is expected to return such that she/he can reply to the message. The expected return of the user will allow she/he to begin again (resume) reply to the messages thus allowing the system to send the reply message back to the sender (normal mail delivery service). It is the combination of Tomkow in view of Horvitz that discloses the alleged missing limitations.

To be clear, the limitation at issue is "an estimate of when normal mail delivery service can resume."

Referring to the above-reproduced passage, the Examiner's both presented new analysis and a new citation within Horvitz. Specifically, the Examiner cited paragraph [0268] of Horvitz, which is reproduced below:

A notification and/or alerting system may also estimate when the user is expected to return, such that it transmits priorities that are expected to be important before the user is expected to return. This can be achieved by learning user-present and user-away patterns over time. The user can then set suitable policies in terms of when he or she is expected to return to the system to review the priorities without being alerted to them. The expected time to return determination by the system may be automatically conveyed to senders of highly urgent messages, for example. In this manner, message senders receive feedback when the user is expected to return such that he or she can reply to the messages. The sender may also be informed that his or her message has been conveyed to the user's mobile device, and so forth.

The Examiner correctly points out the Horvitz teaches an "estimate." However, the Examiner incorrectly alleges that Horvitz teaches the other limitations for which the Examiner has admitted that Tomkow fails to teach. Specifically, the "estimate" described by Horvitz is of "when the

1 user is expected to return." In contrast, the claimed estimate is "when normal mail delivery
2 service can resume." These are two entirely different estimates.

3
4 Returning to the analogy of "snail mail," the concept of "normal mail delivery service,"
5 given its plain and ordinary meaning to one skilled in the art, simply means that the mail has
6 been delivered to its intended recipient. Moreover, for normal mail delivery service "can
7 resume," as claimed, the normal mail delivery service must have been impaired (e.g., stopped).
8 The teachings of Horvitz, however, does not contemplate the need for normal mail delivery
9 service to be resumed since the normal mail delivery service has not been impaired. Whether or
10 not a recipient of e-mail (or "snail mail") is available to read the mail is immaterial to whether or
11 not "normal mail delivery service" exists. The Examiner's unstated claim construction ignores
12 that the service is a delivery service. Thus, estimates as to mail reading (i.e., dependent upon
13 when a user is expected to return) are not relevant to the claimed limitations.

14
15 Therefore, the Examiner has not properly interpreted the language of the claims and since
16 the Examiner's analysis is based upon an improper claim construction, the Examiner has
17 committed reversible error by not properly comparing the claimed limitations to the teachings of
18 the applied prior art. Moreover, the applied prior art fails to teach the limitations for which the
19 Examiner is relying upon the applied prior art to teach.

Rejection of claim 7 under 35 U.S.C. § 103

On page 13 of the Second Appeal Brief, Appellants presented separate arguments as to dependent claim 7. The Examiner's response to these arguments is found on page 15 of the Examiner's Answer and is reproduced below:

Delaney, similarly teaches that "consulting a data store of the state information for selected ones of said respective mail servers to recall an already identified impairment". Specifically, Delaney's transaction server 150 checks (consults) the storage (data store) of recipients schedule (state information) for database 152 (selected one of said respective mail servers) to retrieve (to recall) customers specified (already identified) unavailability to receive (e.g., blackout period) (i.e., impairment associated with the customers), see par 0058 and 0059. Therefore, the combination of Tomkow in view of Delaney teach the limitation of consulting a data store of the state information for selected ones of said respective mail servers to recall an already identified impairment. (emphasis added)

Although apparently not recognized by the Examiner, the term "state information" is an extremely well-known term of art. State information refers to the operational properties (i.e., "state") of the "respective mail servers." However, the Examiner's alleged state information refers to properties of the customers. Specifically, the information identified by the Examiner has nothing to do with the properties of the "respective mail servers." Instead, the alleged state information taught by Delaney is of the customers.

Therefore, the Examiner has not properly interpreted the language of the claims and since the Examiner's analysis is based upon an improper claim construction, the Examiner has committed reversible error by not properly comparing the claimed limitations to the teachings of the applied prior art. Moreover, the applied prior art fails to teach the limitations for which the Examiner is relying upon the applied prior art to teach.

For the reasons set forth in the Second Appeal Brief, and for those set forth herein, Appellants respectfully solicit the Honorable Board to reverse the Examiner's rejections under 35 U.S.C. §§ 101-103.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 09-0461, and please credit any excess fees to such deposit account.

Date: December 29, 2008

Respectfully submitted,

/Scott D. Paul/

Scott D. Paul

Registration No. 42,984

Steven M. Greenberg

Registration No. 44,725

Phone: (561) 922-3845

CUSTOMER NUMBER 46320